

Claim 7

Cancel claim 7.

Claim 8

Cancel claim 8.

Remarks

The specification and claims have been carefully reviewed in light of the examiner's action. Claim 1 has been canceled and rewritten as new Claim 9. Claim 2 has been cancelled. Claims 3 – 6 have been amended to make them dependent on new Claim 9. Claims 7 and 8 have been cancelled. No new matter has been added.

Before taking up the claims in detail attention will be briefly given to the patents cited by the Examiner.

The U.S. Patent to Cassey No. 3,805,055 discloses a removable outdoor light structure which consists of a base member installed in the earth, flush with the upper surface of the earth or lawn with an underground cable extending to a source of electricity. The base member has a socket to removably receive a post member, that has an electric lamp mounted thereto. The post can be removed to mow the lawn with the base member remaining in the earth. Cassey does not disclose a portable lighting fixture that can be placed at various locations, in that its post can be removed from the base, with the base and underground cable remaining in the ground. The light fixture is then not operable as it is disconnected from the electrical source.

In addition, the lighting fixture of Cassey does not have a flexible arm, a terminal connection block or a switch.

The U.S. Patent to Schumaker No. 4,797,798 discloses a medical examining lamp which has a bendable arm with a light fixture attached to it. Schumaker does not disclose a low voltage lighting fixture suitable for outdoor use, a connection block, or the base construction of Applicant.

The U.S. Patent to Landreau et al. discloses a complicated terminal block connector, but no features of Applicant's portable outdoor lighting fixture.

The U.S. Patent to Warshawsky No. 4,880,193 discloses a less than 360 degree lamp swivel, which includes swing arms connected to each other, with a light fixture having a switch. No telescoping pole connected to a base plate, nor a terminal connection block or other features of Applicant's structure are even remotely suggested in Warshawsky.

The U.S. Patent to Natoli et al. No. 6,505,950 B1 discloses a lighted newel post, which is connected to a source of electricity, by a wire having a plug that is connected to a conventional electrical outlet. No features of Applicant's Portable Outdoor Lighting Fixture are even remotely suggested in Natoli et al.

The U.S. Patent to Strickland No. 5,649,764 discloses a lamp base, and lamp base kit. The lamp base includes a stand, which has three disconnected legs, which may be attached thereto by screws. Strickland does not disclose a Portable Outdoor Lighting

Fixture with a terminal connector block, a telescoping pole, a flexible arm or other features of Applicant's lighting fixture.

The U.S. Patent to Zeller No. 4,432,042 is not discussed as it was not relied upon by the Examiner.

The Examiner in rejecting Claims 1-8 of Applicant found it necessary to combine several patents to find Applicant's structure as obvious under 35 U.S.C. § 103(a).

THE APPLICABLE STANDARDS FOR
COMBINING REFERENCES UNDER 35 U.S.C. § 103

The Patent and Trademark Office must prove a *prima facie* case of obviousness of the claimed invention.

"One of the more difficult aspects of resolving questions of non-obviousness is the necessity 'to guard against slipping into the use of hindsight.'" In re Carroll, 601 F.2d 1184, 1186, 202 USPQ 571, 572(CCPA 1979) (quoting Graham v. John Deere Co., 383 U.S. 1,36[148 USPQ 459,474] (1965)). The Patent and Trademark Office has the burden of showing that the prior art would have taught or suggested the claimed invention to one of ordinary skill in the pertinent art, In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

In re Shaffer, 108 USPQ 326, 229 F.2d 476 (CCPA)\1956) is one of many cases in which it is pointed out that for a combination of old elements to be patentable, the elements must cooperate in such a manner as to produce a new, unobvious, and

unexpected result, citing In re Kaufman, 39 CCPA (Patents) 769, 193 F.2d 331, 92 USPQ 141, and In re Lindberg, 39 CCPA (Patents) 866, 194 F.2d 732, 93 USPQ 23.

"Furthermore, as a general matter, in determining patentability, the concept of a new and useful improvement must be considered along with the actual means of achieving the improvement. In re Delancy, 34 CCPA (Patents) 849, 159 F.2d 737, 72 USPQ 477. In re Bisley, 39 CCPA (Patents) 982, 197 F.2d 355, 94 USPQ 80".

When a rejection on obviousness depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998), In re Beattie, 974 F.2d 1309, 1311-12 (Fed. Cir. 1992), In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1987), In re Nomiya, 509 F.2d 566 (CCPA 1975). The Court held in In re Rouffet, *supra*, that the PTO must describe the basis for its decision and specifically identify the principle, known to one of ordinary skill, that suggests the claimed combination.

On page 1459 the Court in In re Rouffet, *supra*, held:

...As this Court has often noted, invention itself is the process of combining prior art in a nonobvious manner...the Board must identify specifically the principal, known to one of ordinary skill, that suggests the claimed combination.

...explaining that the Board's opinion must describe the basis for its decision. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

The Court went on to hold that every invention has prior art elements, and the PTO may not use the claimed invention itself as a blueprint to put together elements of the prior art to defeat the claimed invention.

Obviousness is determined from the vantage point of a hypothetical Person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). This legal construction is akin to the "reasonable" person" used as a reference in negligence determinations. The legal construction also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. See In re Carlson 983 F.2d 1032, 1038 (Fed. Cir. 1993).

As the court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983); see also Richdel, Inc., v. Sunspool Corp., 714 F.2d 1573, 1579-80, (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements.") Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerasonic Corp., 81 F.3d 1566, 1570 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick

and choose among isolated disclosures in the prior art to defeat the claimed invention. In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Here, the Examiner went through a process of “picking and choosing” from the elements of the prior art to reconstruct the present claim. Bausch & Lomb, Inc. v. Barnes Hind Hydrocurve, Inc., 796 F.2d 443 (Fed. Cir. 1986).

The CAFC has held that the PTO may not present an “obvious to experiment” standard in order to establish obviousness. In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

An “obvious-to-try” situation exists when a general disclosure may pique the scientist’s curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. The CAFC has held that “obvious-to-try” is not to be equated with obviousness. Gillette v. Johnson, 919 F.2d 720 (Fed. Cir. 1990).

The CAFC in In re Chu, 66 F.3d 292 (Fed. Cir. 1995), reversed the Board on their decision of obviousness. It held that in a proper obviousness determination i.e. whether the changes from the prior art are minor, the changes must be evaluated in terms of the whole invention. This includes what could be characterized as simple changes.

Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down. In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984).

The CAFC in a recent case set forth the proper inquiry for evaluating references as:

References must be considered for all that they teach. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983) cert. Denied, 469 U.S. 851 (1984).

See also In re Fritch, Supra.

In combining references, the Examiner did not and could not:

1. Find any suggestion of the desirability of the proposed combination;
2. Find any suggestion for combining the references in the references themselves;
3. Find any suggestion in the references taken as a whole of the structure claimed;
4. Find the actual structure as claimed and employed to achieve a new and unexpected result.

Claim 9, former Claims 1, 7 and 8 combined and rewritten calls for a portable outdoor lighting fixture, having a base with a hollow pole extending from the base, a flexible arm connected to the pole means, a shade assembly connected to the arm, the shade assembly having a low voltage bulb, the base having a low voltage bulb, the base having a base plate with a terminal connector block, with wire means connecting the block and shade, a low voltage transformer remote

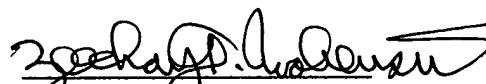
from the fixture connected to a source of electrical energy, with the base plate having at least three legs.

This structure is not found in the references alone or in any reasonable combination.

Claims 3,4,5 and 6 dependent on new claim 9 with all its limitations also define structure not found in the references alone or in any reasonable combination.

Accordingly, it is believed that the application is in condition for allowance and such action is requested and urged.

Respectfully submitted,


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I CLAIM

~~1. A portable outdoor lighting fixture comprising:~~

base means,
hollow pole means extending vertically from said base means,
a flexible arm connected to said pole means,
a shade assembly connected to said arm,
said shade assembly including a low voltage bulb therein,
said base means including a base plate,
a terminal connector block attached to said plate on the side opposite from
said pole means,
wire means connected to said block and to said shade assembly,
said shade assembly includes a switch connected to said wire, and
a low voltage transformer connected to a source of electrical energy, and a
supply wire connected to said transformer and to said connector block to supply low
voltage to said fixture.

~~2. A lighting fixture as defined in Claim 1 in which,~~

~~said base means includes a base supporting said fixture.~~

3. A lighting fixture as defined in Claim 1 in which,
said plate has a spike connected thereto to stick in the ground to provide
support to said fixture.

4. A lighting fixture as defined in Claim 1 in which,
said terminal block has a plug connected to said low voltage supply wire and
engaged in said block.

5. A lighting fixture as defined in Claim 1 in which,
said wire means and said supply wire are engaged in said block.

6. A lighting fixture as defined in Claim 1 in which,
said wire means and said supply wire are connected together in said block by
wire nuts.

7. A lighting fixture as defined in Claim 1 in which,
said pole means includes a hollow pole connected to said plate,
a tube in telescoped relation to said pole, and
a compression nut on
~~said pole to grip said tube to retain said shade assembly at a selected height.~~

8. A lighting fixture as defined in claim 2 in which,
~~said base includes at least three legs attached to said plate.~~

9. A portable outdoor lighting fixture comprising;
base means,
hollow pole means extending vertically from said base means,
a flexible arm connected to said pole means,
a shade assembly connected to said arm,
said shade assembly including a low voltage bulb therein,
said pole means includes a hollow pole connected to said plate,
a tube in telescoped relation to said pole, and
a compression nut on

said pole to grip said tube to retain said shade assembly at a selected height,
 said base means including a base plate,
 at least three legs attached to said plate,
 a terminal connector block attached to said plate on the side opposite from
 said pole means,

 wire means connected to said block and to said shade assembly,
 said shade assembly includes a switch connected to said wire, and
 a low voltage transformer remote from said fixture connected to a source of
 electrical energy, and a supply wire connected to said transformer and to said connector
 block to supply low voltage to said fixture.